

Remarks:

Status of Application

The Office Action dated December 13, 2002 rejected claims 1-26. Claims 1-19 and 26 are cancelled herein without prejudice as being drawn to a non-elected invention. Claims 21, 22, 24 and 25 are also cancelled herein without prejudice. Claims 20 and 23 are pending as amended herein.

Interview Summary and Restriction Requirement

The applicants appreciate the courtesy shown their representatives in a telephone interview on April 14, 2003. During that discussion, distinctions between the composition and method claims were discussed. A restriction requirement was then issued restricting the application to composition claims (claims 1-19 and 26) or method claims (claims 20-24). In response, the applicants elect claims 20-24, and cancel claims 1-19 without prejudice as drawn to a non-elected invention.

Amendments to Pending Claims

The Office Action indicated that claim 21 would be given favorable consideration, with recommended amendments. Claim 21 depends directly from claim 20. Applicants have amended claim 20 to incorporate all the limitations from claim 21 and cancelled claim 21 herein. Applicants have further amended claim 20 as suggested at page 6 of the Office Action. In accordance with the recommendations of Office Action, claim 20, as amended, (1) is directed a method for brightening a chemical pulp, (2) recites a Mg:SiO₂ mass ratio of between about 1:10 to about 1:3, and (3) addresses the 35 USC § 112 paragraph 2 rejection by referring to SiO₂ throughout the claim, removing any ambiguity as to the nature of the term "silicates." Claim 23 depended from claim 22 and has been amended to depend from claim 20, as claim 22 has been cancelled.

Reference by Francis et al. is Not Prior Art

At page 4 of the Office Action, a rejection of claims 1-26 over a document by Francis et al. is maintained. The Office Action indicated a need for clarification regarding the Francis et al. document. The document in question was submitted

to the USPTO in an Information Disclosure Statement. The document was an internal communication between the co-inventors. The document, written by Dr. Francis, was submitted to National Silicates Ltd., which is an assignee of the present invention. The February 7, 1997 date that appears on the document cover sheet merely reflects the date the document was submitted to National Silicates Ltd., and in no way represents a publication date, or public disclosure date.

A Declaration by Raymond C. Francis was submitted with a response on September 23, 2002. This declaration stated that the Interim Report submitted to National Silicates Ltd. in February 1997 was an internal communication between research collaborators, and not intended to be publicly disclosed in any manner. Dr. Francis also stated that to the best of his knowledge, the Interim Report was not published, distributed, or disclosed outside of the research collaboration of National Silicates Ltd. and the State University of New York, Syracuse.

The Office Action noted that the September 20, 2002 declaration by Dr. Francis stated that the first known publication of the subject matter in the report was in January 1998. Subsequently, a second declaration by Dr. Francis ("October 21, 2002 declaration") was submitted with a response filed October 23, 2002. In his second declaration Dr. Francis stated that after signing his first declaration, he reviewed the details concerning published subject matter related to the interim report. Upon review of his records, Dr. Francis established that the first known publication of the relevant subject matter was later than January 1998. In the October 21, 2002 declaration Dr. Francis stated that the first related disclosure of the material was made, in confidence, to the attendees of a meeting of the Empire State Paper Research Associates (ESPRA) held May 19-22, 1998. The disclosure included a research report that is provided with the enclosed Information Disclosure Statement. A copy of the October 21, 2002 declaration by Dr. Francis is enclosed for the convenience of the Examiner.

In response to the Examiner's request for information regarding the first disclosure of the subject matter in the Interim Report cited, the applicants are filing herewith an Information Disclosure Statement including the paper presented to attendees of the ESPRA meeting. The paper's date of distribution is

May 19, 1998. The priority date of the application is May 15, 1998, thus the enclosed paper is not prior art and is not material to patentability.

The Office Action stated that the filing date of the present application is January 11, 2001. The application satisfied the requirements for nationalization under 35 U.S.C. § 371 on January 11, 2001. While nationalization occurred in January 2001, the application is entitled to a priority date of May 15, 1998, as claimed on the inventors' declaration, and acknowledged by the United States Patent and Trademark Office in the Office Action dated September 19, 2001 (Paper No. 6). Thus, any disclosure at the ERPRA meeting between May 19-22 occurred after the effective filing date of the present application.

Summary

In view of the foregoing amendments and remarks, applicants submit that this application is in condition for allowance and respectfully request early and favorable notification to that effect. If it would expedite prosecution of this application, the Examiner is invited to confer with Applicants' undersigned representatives.

Respectfully submitted,



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PDP/

Enclosures: Copy of Second Declaration of Raymond C. Francis;
Information Disclosure Statement
Extension of Time (2 months)

Dated: May 13, 2003

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The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on:

May 13, 2003

Date


Christopher R. Lewis